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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,965	03/28/2001	Takao Yoshimine	275745US6	4221

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

NOTIFICATION DATE	DELIVERY MODE
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01/17/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

09/819,965

**Applicant(s)**

YOSHIMINE ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-43, 45-54, 56-65, 67-69, 97 and 98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-43, 45-54, 56-65, 67-69, 97 and 98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 October 2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 37-43, 45-54, 56-65, 67-69, 97 and 98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for three reasons. First, the distinction between content "creator" and content "provider" (e.g., respectively at claim 48 lines 4 and 2) is based solely on ownership and is therefore inherently indefinite.
4. There is a simple common sense difference between those who create content and those who subsequently distribute (provide) said content. However, this simple understanding is not sufficiently definite to enable its use as a patent limitation. First, the Supreme Court has found that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). It follows that an "artificial being" "existing only in contemplation of law" can be created, merged, diffused or destroyed merely at human whim.
5. Ownership is inherently indefinite because it is not concrete (predictable). In accordance with the *State Street* decision (MPEP § 2106.II.A), ownership limitations cannot impart patentability. Consider a recent real world case. *Pixar Animation Studios* is a major (animated motion picture) content creator. For many years Pixar's content was distributed or provided to consumers exclusively by *The Walt Disney Company* (*Holson et al.*, caption

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of image on p. 1 of 4). Assume a US patent had been granted with separate "content creator" and "content provider" limitations applicable respectively to Pixar and Disney. In early 2006, Disney bought Pixar (*La Monica*). The creator Pixar ceased to exist as an entity independent of the provider Disney. What then would the status of the hypothetical US patent be? Would it cease to be applicable to Disney and Pixar at the moment the Pixar buyout was effected? Now, what if Disney decides to make "Pixar" a separate corporation, but retains 50% ownership, and perhaps decides to do some of the creative work in-house and farm some to Pixar. Does the hypothetical US patent apply to this half-independent "creator" doing "some" of the creative work? And what is the patent status of the "provider" Disney that also does some of the creative work?

6. US patent claims can be meaningfully limited only by concepts with reasonable predictability. The metal titanium is a meaningful claim limitation because it is reasonable certain that it cannot suddenly change into aluminum, at least not at human whim. No such predictability exists for an ownership limitation, including the disclosed distinction between "content creator" and "content provider". Applicant assumes a clear distinction, but in fact either entity can appear, disappear or be merged or diffused with other entities merely at human whim. "Content creator" and "content provider" lack the concreteness required by the *State Street* decision. The claimed distinction between the creator and provider of content is inherently indefinite.
7. Second, for the same reasons, the distinction between "*Internet* service provider" and "*application* service provider" (at claims 40, 51 and 62) is based solely on ownership and is therefore inherently indefinite.
8. Third, in each independent claim 37, 48, 59 and 97, the phrase "appointed by the personal computer of the content creator" (e.g., at lines 6-7 of claim 48) is indefinite. It is not clear how a computer can "appoint".

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 37-43, 45-54, 56-65, 67-69, 97 and 98 are rejected under 35 U.S.C. 103(a) as being obvious over Logan et al. (US005721827A).

11. Logan et al. teaches (independent claims 37, 48, 59 and 97) an apparatus, method and computer readable storage medium for determining a *content provider royalty payments*, which reads on a share of profits (para. 13 below), the method comprising:

receiving first predetermined information of a content provider (the *public key*, col. 10 lines 21-26) and for storing first predetermined information (said storing being inherent if said encryption key is to be useful);

receiving from a personal computer (para. 13 below) of the content creator (*data sources 401*, col. 35 lines 14-15) via internet (col. 35 lines 16-17), content data (*programming*, col. 1 lines 39-47) and predetermined information including at least category information indicating genre of the content data (*subject category* and *program topic descriptions*, col. 1 lines 56-60 and col. 28 lines 29-31) and "second" predetermined information including at least category information indicating genre of the content data which is appointed by the content creator<sup>1</sup> (*the human author*, col. 36 lines 5-7) with a personal computer;

accessing the content data (*programming*) provided by received from the content creator, the content data including advertising data (*programming and advertising segments*, col. 6 lines 56-60);

transmitting, via a network (col. 4 line 13 and Fig 1) selected content data/*programming* to one or more user locations (players 103, col. 2 line 63 to col. 3 line 9), in response to a request from the one or more user locations for the selected content data/*programming* (col. 6 lines 45-51);

calculating *royalties*, which reads on a share of profits (para. 13 below), to be earned by the content creator as a function of the number of transmissions of the selected content data/*programming*, and whether the selected content included advertising data (col. 20 lines 3-20); and

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<sup>1</sup> "Appointed" is interpreted to mean selected by the content creator (published appl. para. [0147]).

storing the *royalty payments*/share of profits to be paid to the *content provider*/content creator in a content creator information database (*Content Providers Table 315*, col. 27 lines 8-9).

12. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
13. The instant application contains no such clear definition for any of its terms. First, "profit" is not given a "clear definition" in the specification, and indeed has no precise definition in accounting. Logan et al. teaches paying *royalties to content providers* (col. 6 lines 8-9). A "royalty" is defined as a profit share or other payment to an author or composer (Merriam-Webster's Collegiate® Dictionary, 10<sup>th</sup> ed.) Hence one of ordinary skill in the art would understand that *royalties provided to content providers* reads on the claimed "share of profits for the content creator". Second, "personal computer" is widely used in the spec. to mean the computer functionality of the actors (Fig. 2 and para. [0086]), so that is the interpretation used here.
14. The distinction between "content creator" and "content provider" cannot be given patentable weight. The spec. (para. [0087]-[0088] and Fig. 2 of the published application, US 20020046097A1) suggests the "content creator" and "content provider" are separate business entities. That is an ownership distinction, which is inherently indefinite (para. 2-6 above). The broadest reasonable interpretation is that "content creator" and "content provider" designates a job distinction, comparable to "writer" and "publisher" at a newspaper. From the point of view of patentability, this is a non-functional distinction.

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15. It has been noted (para. 13) that Logan et al. teaches paying *royalties* to *content providers*, which, by definition, reads on the claimed calculating and storing a share of profits to be earned by the content creator. Strictly, the *content provider* in Logan et al. corresponds to the claimed "content creator". The *host 101* in Logan et al. (col. 2 lines 63-66 and Fig. 1) corresponds to the claimed "content provider". However, these are patentably non-functional job distinctions. Logan et al. recognizes the inherent indefiniteness and variability of job distinctions:

"The Accounts Table seen at 321 in FIG. 4 is indexed by a key value AccountNo which is unique to each of its Account records. The fields of those records contain name, mailing address, telephone, fax and email information for all subscribers, advertisers and content providers in a single shared file. A person or firm specified by a record in the Accounts Table could simultaneously be a subscriber, advertiser and a content provider, in which case the same AccountNo key value would appear in each of the three tables: Subscribers 313, Content.sub.-- Providers 315 and Advertisers 317." (Logan et al. col. 20 line 64 to col. 21 line 7, emphasis added.)

Although the *host 101* is mentioned briefly, Logan et al. generally distinguishes only between three jobs: *subscriber*, *advertiser* and *content provider*. Logan et al. generally uses the term *content provider* to subsume both the claimed "content creator" and "content provider", much as *newspaper* would subsume both the writer and publisher within said newspaper.

16. Logan et al. does not teach authenticating the personal computer of the content creator based on said first predetermined information, the public key (col. 10 lines 21-26). Because Logan et al. teaches the encryption of all non-public information transmitted over the Internet (col. 10 lines 21-23), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Logan et al. that authentication of the personal computer of the content creator be based on said first predetermined information/*public key*.
17. No patentable weight was given to the content data including "advertising data affixed thereto, said advertising data being affixed based on commercial desired data generated in response to a selection by the content creator", because this limitation is nonfunctional descriptive material (MPEP § 2111.01). The US Patent & Trademark Office does recognize a distinction between "advertising" and other content when there is some functional basis.

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If, as in the instant case, the advertising is merely part of the content, then there is no patentable distinction. Logan et al. does teach "advertising data affixed thereto", but it is based on a functional selection by the *subscriber* actor (col. 9 lines 5-11), not by the non-functional choice of the "content creator" actor.

18. Also, as was noted in the Office action mailed 9 April 2007 (para. 11), because anything promotional is "advertising" (e.g., the mere mention of a product or brand name is "advertising"), it is very common for content to have "advertising data affixed thereto, said advertising data being affixed based on commercial desired data generated in response to a selection by the content creator" (i.e., chosen by the creator to make the work commercially valuable). Hence, even if the subject limitation were given patentable weight, it is very common and therefore obvious.

19. Logan et al. also teaches (claims 40, 51 and 62) that the calculating step calculates the *royalties/share of profits* to be earned by the content creator by (col. 19 line 63 to col. 20 line 23):

retrieving data representing a number of times (*Plays field*) the content data created by the content creator was accessed by users of the application service provider, and

determining an amount of money (*Amount*) that corresponds to the number of times the content data created by the content creator was accessed by users of the application service provider.

Logan et al. also teaches "service user charges" as *subscriber billing charges* (col. 15 lines 35-41). Logan et al. does not explicitly teach that these charges are the sum of a "connection fee" and a "service fee". However, since Logan et al. teaches an ISP and an "application service provider" (respectively *ISP 121* and *Host 101* in Fig. 1), the *subscriber* must inherently pay whatever charges each of these actors levies. It would be an obvious convenience to pay these fees together as the claimed "service user charges".

Logan et al. does not teach

subtracting the amount of money that corresponds to the number of times the content data created by the content creator was accessed by users of the application service provider from the service user charges to determine the share of profits to be earned by the content creator.



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However, this definition of "share of profits" is only semantically and arbitrarily different from the *royalties* taught by Logan et al., and was accordingly not given patentable weight. The instant invention determines the "amount of money" before "service user charges", so "share of profits" is defined as the difference between the two. Logan et al. determines *Amount* (of money) independent of (after) *subscriber billing charges*, so said *Amount* is equal to the *royalties*/share of profits.

20. Logan et al. also teaches at the citations given above claims 38-39, 49-50 and 60-61; claims 41, 52 and 63; and claims 45, 56 and 67 inherently.
21. Logan et al. also teaches claims 42, 53 and 64 (col. 9 lines 62-63); 43, 54 and 65 (col. 9 lines 5-11, where *defray subscription costs* reads on applying the credit to a purchase over the network); and claims 47, 58 and 69, where *royalty payments due to content providers* (col. 15 lines 40-41) reads on contributions.
22. Logan et al. does not teach (claims 46, 57 and 68) that the ad is placed at the head (beginning) of the content. Because it is common practice to begin programming with advertising, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to the teachings of Logan et al. that the ad is placed at the head (beginning) of the content.
23. Logan et al. also teaches (claim 98) that the registering means creates a user information database table (*Content Providers Table 315*, col. 16 lines 38-49) based on the first predetermined information ("based on" being interpreted as necessary for access), and stores data representing a number of times the content data created by the content creator was accessed by users of the application service provider (col. 16 lines 50-54). Logan et al. also teaches the Internet service provider connecting the personal computer of the content provider to the Internet and the application service provider storing the content data (col. 4 lines 7-13 and Fig. 1).

Logan et al. does not explicitly teach that the registering means "matches a URL to a user ID of the content creator, stores the matching URL and the user ID of the content creator in the user information database table, supplies the personal computer of the content creator with automatic upload software programmed to automatically connect to the URL matching the user ID of the content creator and to store the content data created by the content creator in an exclusive memory area in a server oriented to the URL". However, these were

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all well-known useful, and therefore obvious, functionalities at the time of the instant invention.

Logan et al. does not explicitly teach that the registering means "stores a connection fee of an Internet service provider and a service fee of an application service provider", but the storage of fee data is necessary to invoice and pay the fees, said fees being inherent to Logan et al. (para. 19 above).

### ***Response to Arguments***

24. Applicant's arguments filed with an amendment on 24 August 2007 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection presented herein.
25. In particular, applicant argues (p. 13) that "'content creator' should not be construed as having the same meaning as 'content provider.'" The problem is that both are ownership limitations, which are inherently indefinite and do not meet the *State Street* requirements for a patentable limitation (para. 2-6 above).

### ***Conclusion***

26. This is a continuation of applicant's earlier Application No. 09819965. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
27. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

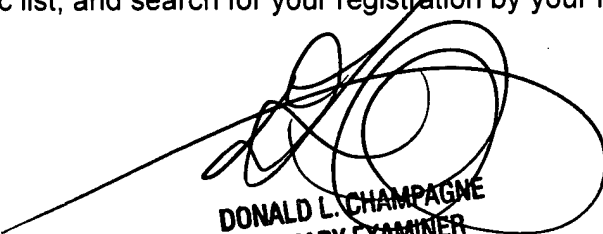
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28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
29. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
31. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
32. Applicant may have after final arguments considered and amendments entered by filing an RCE.
33. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov).

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6 January 2008

  
DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622